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10/065,969	12/05/2002	Janet Elizabeth Opel	Rev 98-19	3818
26807	7590	04/12/2005	EXAMINER	
JULIE BLACKBURN REVLON CONSUMER PRODUCTS CORPORATION 237 PARK AVENUE NEW YORK, NY 10017			YU, GINA C	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/065,969

Applicant(s)

OPEL ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

Receipt is acknowledged of amendment filed on December 6, 2004. Claims 1-20 are pending. Claim rejections made under 35 U.S.C. § 112, second par. are withdrawn in view of claim amendment made by applicants in part and maintained in part. As applicants have correctly pointed out in response, claims 1-16, 18, and 19 have been rejected under 35 U.S.C. § 103 (a) as unpatentable over Croda (Personal Care, Super Sterol Ester) in view of Jacks (US 5690918) and Mercado et al. (US 4996044), with the Croda reference as the primary reference. Correction is made in this Office action.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, the structure of the recited sterol is incomplete because the structure lacks a hydroxyl group.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In view of the provisions of 35 U.S.C. 103(a), the examiner presumes that the various claims were commonly owned at the time any invention claimed therein was made absent any evidence to the contrary. Applicant is advised to file a statement under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Croda (Personal Care, Super Sterol Ester) in view of Jacks et al. (US 5690918) and Mercado et al. (US 4996044) ("Mercado").**

Claimed invention is a composition comprising 1) 0.5-30 % of a stick structuring agent which is a solid or semi-solid at room temperature and has a melting point of 34-38 C; 2) 10-90 % of a nonvolatile oil which is selected from the group consisting of triisostearyl citrate, trioctyldodecyl citrate and mixture thereof; 3) 1-30 % of a wax comprising a fatty alcohol; and 4) 0.1-25 % of particulate matter having a particle size of 0.5 to 200 microns.

Croda teaches a lipstick formulation comprising 1) 7.39 % of C10-30 cheolesterol/lanosterol esters; 33.63 % of Oleyl alcohol; 7.712 % of pigments. See Technical Data, p. 5. See p. 2, second par. The melting point of Super Sterol Ester is said to be 30-38 C. The reference teaches that Super Sterol Ester "produces elegant sticks, improving their skin feel and giving them a creamy pay-off", and exhibits

"excellent spreading ability and provides good adhesion to skin care systems". See p. 2, second par. The ester is also said to be "these anhydrous" "considered the ingredient of choice for lipsticks". See Id.

Croda fails to teach the claimed volatile oil.

Jacks teaches lipstick formulations comprising 1 % of trioctyldodecyl citrate. Examples. The reference teaches that, to provide "desirable feel, spreadability, gloss and other desirable characteristics". Mixture of low viscosity and high viscosity oil soluble liquids are used. High viscosity oils include triesters of citric acids. See col. 5, line 66 – col. 6, line 9. Example formulations also comprise cyclomethicone and acrylate copolymer. See instant claims 13 and 19. Polyethylene wax is also taught in col. 5, lines 35 – 40. While cetyl alcohol and oleyl alcohol are taught, the reference teaches these as low viscosity oils. See col. 5, lines 49 – 65.

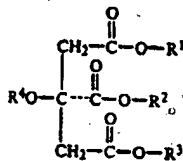
Mercado teaches that cetyl alcohol and stearyl alcohol are wax feel enhancers and structure strengtheners useful for lipstick formulation. See col. 4, lines 8 – 18.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the lipstick composition of Croda by adding the triester of citric acid as motivated by Jacks because of the expectation of successfully producing a lipstick composition which provides good skin feel, spreading ability and gloss when applied. Selecting cetyl alcohol wax to make the composition of the combined references would have been also obvious in view of Mercado because of the expectation of successfully enhancing the feel of and strengthen the structure of the composition.

Claims 17 and 20 are rejected under 35 U.S.C. 103 as being unpatentable over Croda, Jacks, and Mercado as applied to claims 1-3, in view of Natraj et al. (US 5244665) ("Natraj") and Clement above, and

While the combined references fail to teach "triisostearyl citrate", (US 5,185,071).  
"Other triesters of citric acid, such as disclosed in US Pat. No. 5244665" may be used in place of some or all of trioctyldodecyl citrate. See col. 6, lines 2 - 6.

The U.S. Pat. No. 5244665 is issued to Natraj et al., and teaches triester of citric acid having the structure



where R1, R2, and R3 each independently represent a branched or unbranched alkyl, alkenyl, aryl, alkyl-aryl or arylalkyl group, each said group being optionally substituted and having from 1 to 18 carbon atoms, R4 representing H2 or a branched or unbranched saturated or unsaturated acyl, alkyl, aryl, alkyl-aryl or alkylaryl group, each said group being optionally substituted and having from 1 to 18 carbon atoms. Thus triisostearyl citrate limitation is met. The reference teaches that the triesters are used to treat photodamaged and/or or hyperpigmented skin, and to slow down aging process generally. See col. 2, lines 3 - 11.

Clement teaches that a combination of volatile silicone fluid, a non-volatile silicone gum and a C16-C22 fatty acid ester of citric acid produces a cosmetically desirable tacky feeling. Triisostearyl citrate is particularly demonstrated in the reference. See Examples.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by substituting the trioctyldodecyl citrate with triisostearyl citrate as motivated by Natraj and Clement because 1) all the references are in cosmetic art known to the routineer; 2) Jacks teaches that triisostearyl citrate is within the scope of the suitable citric acid triesters for the lipstick formulation; and 3) Clement teaches that trioctyldodecyl citrate produces cosmetically desirable properties when combined with volatile and nonvolatile silicone compounds which are also used in Jacks formulations (cyclomethicone, silicone gum). In combining the teachings of these references, the routineer would have had a reasonable expectation of successfully producing a lipstick composition, which produces a cosmetically desirable tacky feeling.

### ***Response to Arguments***

Applicant's arguments filed December 6, 2004 have been fully considered but they are not persuasive.

Applicants also assert that it is the combination of volatile and nonvolatile oils that provides the benefits the examiner cited from the Jack reference. Examiner respectfully disagrees, as the reference specifically teaches that these benefits are rendered by the oily liquids used in the prior art. There is no teaching in the reference that these benefits are obtained by specific mixture of oily liquids only.

Applicants assert that the Jack reference fails to provide motivation to add the triester of citric acid into the Croda lipstick composition allegedly because the Croda product already sufficiently provides good skin feel and creamy textures and thus there

would be no need for the proposed combination with the teachings in the Jack reference. Examiner respectfully disagrees, because the triester of citric acid provides glossy property which is not taught by the Croda reference. Furthermore, applicants' assertion that one would not be motivated to further improve the Croda product is viewed a subjective opinion, whereas the objective view would be that one of ordinary skill in the art would be encouraged and motivated to improve their products. Also, it is well known in the idea for combining compounds each of which is known to be useful for the same purpose, in order to form a composition which is to be used for the same purpose, flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of conventional moisturizing oils in lipstick compositions. It would follow that the recited claims define prima facie obvious subject matter.

Applicants also argue that Natraj fails to explicitly teach the use of triisostearyl citrate in a lipstick composition. The argument is unpersuasive because Jacks provide the specific teaching that the triesters of citric acid disclosed in Natraj patent is useful to make lipsticks. While applicants assert, "missing from this list is the triisostearyl citrate in question", examiner respectfully points out that the compound is taught as a species of the genus taught in the constituents of formula (I).

In regards to the teachings in Clement, applicants assert that the benefits of isostearyl citrate as taught by Clement, i.e., "slightly tacky consumer-appealing



residue", "would not be desirable in a lipstick". The argument is supported by any objective evidence to establish nonobviousness in this case.

### **Conclusion**

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application  
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Gina Yu  
Patent Examiner

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER